

U.S. Patent Application No. 09/917,435
Attorney Docket No. RD-28615 (07783-0073)

REMARKS

The Office Action mailed October 12, 2004 has been received and carefully considered. Upon entry of the present amendment, claims 1-2, 4-11, and 13-20 will be pending. Claims 1, 9, and 16 are independent. In view of the Pre-Appeal Brief Request for Review filed July 28, 2005, the prior rejections have been withdrawn and new rejections propounded.

In the Office Action, claims 1-20 stand rejected. Claims 1-2, 7-11, 14-16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as assertedly unpatentable in view of certain select pages of Towers' Dreamweaver 2 for Windows and Macintosh, 1999, Peachpit Press (Towers). Claims 3-4, 6 and 12 stand rejected under 35 U.S.C. § 103(a) as assertedly obvious over Towers in view of U.S. Patent 5,758,093 to Boezeman et al. (Boezeman). Claims 5, 13 and 17 stand rejected as assertedly obvious over Towers in view of Boezeman and further in view of U.S. Patent 4,713,754 to Agarwal et al. (Agarwal).

Reconsideration of the Application is respectfully requested.

I. Amendments to the claims.

Claims 1, 4-6, 9-10, and 13 have been amended. Claims 3 and 12 are cancelled. The amendments are fully supported by the specification as originally filed and present no new matter.

II. Opening Remarks

Applicants were successful in overcoming the Final Rejection of May 5, 2005 by identifying clear error in the rejections in a Pre-Appeal Brief Request for Review. Applicants note that at one point subsequent to filing the Pre-Appeal Brief Review request, a Panel Decision, viewed by Applicants using PAIR, indicated that the Final Rejection had been overturned and that a Notice of Allowance would be mailed. No copy of this decision was ever

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provided to Applicants; shortly thereafter, the Panel Decision indicating that a Notice of Allowance should be mailed was no longer available on PAIR. Subsequently, a second Panel Decision, a copy of which was mailed to Applicants, was published to PAIR, in which the report indicated that a new Office Action would be mailed.

The new Action, i.e., the instant Office Action, relies on exactly the same art and essentially the same arguments already presented; it merely changes the characterization, restating the primary rejection from a §102 rejection to a §103 rejection. Despite applying the same art, Applicants continue to receive no response why Towers is an adequate primary reference when only selected portions of Towers have been provided to Applicants, and even those select portions provided are incomplete.

Towers is a reference guide that is at least 355 pages long (based on the highest numbered page cited by the Examiner). Yet, the Examiner has only provided Applicants 15 non-consecutive pages – 2 of which include the cover and inside cover – selecting only those that purport to support the Examiner's position. One of ordinary skill in the art consulting only these pages would not appreciate that the Towers teaches or suggests Applicants' claimed invention, particularly since there is no evidence that the limited information found on these non-consecutive pages all interrelate in the same way as Applicants' claimed invention.

Further, those few pages that are provided are incomplete. For example, the Examiner relies on page 233 of Towers in rejecting each of the independent claims. Yet, page 233 begins at step 3 of a process that is at least 7 steps. No preceding or following pages have been provided to Applicants to aid in the context of what Towers is actually teaching. For example, of the steps numbered 3-7 that are listed on page 233, step 3 refers to a Figure that has been only partly reproduced. Steps 4, 5, and 7 each direct a reader elsewhere in the text for a definition of

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a term or explanation of a process, although none of these pages nor their contents have been provided to Applicants.

Thus, one of ordinary skill in the art consulting those portions of Towers which the Examiner has cited would not be enabled to make and use anything, much less arrive at Applicants' claimed invention. Furthermore, because even the selected portions used against Applicants' claimed invention are themselves incomplete, Applicant is unable to adequately analyze the cited reference to provide a complete response, such as determining whether the pages that have not been provided to Applicants teach away from Applicants' claimed invention.

If the Examiner maintains the rejection, Applicants explicitly request that the Examiner provide Applicants a complete copy of Towers to permit Applicants to fully analyze the reference.

III. Ground 1: Claims 1-2, 7-11, 14-16, and 18-20.

Claims 1-2, 7-11, 14-16 and 18-20 stand rejected as assertedly obvious over Towers. Applicants respectfully traverse the rejection.

Independent claims 1 and 9 have been amended to incorporate the limitations of claims 3 and 12 respectively, neither of which were rejected on this ground. Thus, for at least this reason, this rejection should be withdrawn as to claims 1 and 9, as amended, and all claims depending therefrom.

Applicants incorporate the prior discussion from the Response filed January 3, 2005 and the Remarks accompanying the Pre-Appeal Brief Request for Review pertaining to the impropriety of citing only incomplete portions of Towers in forming the rejection and distinguishing the invention in claim 16 from Towers.

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The computer program of claim 16 executes the steps of providing a visual development environment, wherein the visual development environment includes a visual display of an input form representing a current state of the input form; selecting an input field from a plurality of input field types; customizing a visual appearance of the selected input field using a visual editor of the visual development environment; customizing dynamic behavior of the selected input field using at least one additional visual editor of the visual development environment; incorporating the customized selected input field into the visual display of the input form in the visual development environment; repeating the steps of selecting an input field, customizing a visual appearance of the selected input field, customizing dynamic behavior of the selected field, and incorporating the customized selected input field until all input fields are included in the input form; and generating, in a single file, program code for the input form executable by a web browser to implement the visual appearance and dynamic behavior of the selected input fields of the input form.

In claim 16, Applicants' claimed invention requires customizing dynamic behavior of a field using at least one additional visual editor of the visual development environment. The excerpt from Towers cited by the Examiner with respect to behavior modification (page 233) makes no reference that the behavior modification is a dynamic customization nor whether the behavior modification is taking place in the visual development environment.

Applicants' claimed invention also requires repeating certain steps until all fields are included in the input form. The Examiner admits that Towers fails to teach this limitation, but states that the steps of Towers at pages 140-142 "can be" repeated. Office Action at page 3. "Can be" is not an appropriate legal standard. The Examiner's argument fails to show that the prior art reference teaches the claim limitation, as is required by MPEP 2143.03, which provides

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"[t]o establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." *See also* MPEP 2143.01 (III).

Thus, the rejection as to claim 16, and to claims 18-20, which depend therefrom, should be withdrawn.

IV. Ground 2: Rejections over Towers in view of Boezeman.

Claims 3-4, 6 and 12 stand rejected as assertedly obvious over Towers in view of Boezeman. Independent claims 1 and 9 now contain the limitations of cancelled claims 3 and 12 and are discussed fully here.

Applicants incorporate the prior discussion from the Response filed January 3, 2005 and the Remarks accompanying the Pre-Appeal Brief Request for Review pertaining to the impropriety of citing only incomplete portions of Towers in forming the rejection and distinguishing the invention of claims 1 and 9 from Towers.

The rejection of claims 3 and 12, as applied to claims 1 and 9 as amended, are §103 combination rejections. It is well established that a proper §103 combination rejection requires more than just finding teachings in the references of the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. *See also*, for example, *In re Fine*, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311-313 (Fed. Cir., 1983), and *Ex parte Levengood*, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993). As stated in *In re Fine* at 5 USPQ2d 1598:

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"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

* * * * *

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

* * * * *

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd.Pat.App. & Inter. 1993)."

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Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and for selecting the helpful portions from each reference while ignoring the unhelpful portions. As discussed above, in light of the selected materials provided to Applicants, Applicants cannot even review portions of Towers that may be unhelpful to the Examiner's argument. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure.

Claim 1, like claim 16, requires repeating certain steps until all fields are included in the web page. The Examiner again admits that Towers fails to teach this limitation, but states that the steps of pages 140-142 "can be" repeated. Office Action at page 3. "Can be" is not an appropriate legal standard. The Examiner's argument fails to show that the prior art reference teaches the claim limitation, as is required by MPEP 2143.03, which provides "[t]o establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." *See also* MPEP 2143.01 (III).

Furthermore claim 1 recites in part: "customizing a visual appearance of the inserted field using a visual editor of the visual development environment" and "customizing dynamic behavior of the inserted field using at least one additional visual editor of the visual development environment." The excerpt from Towers cited by the Examiner with respect to behavior modification (page 233) makes no reference that the behavior modification is a dynamic customization nor whether the behavior modification is taking place in the visual development environment.

Claim 1, as amended, further requires that the step of customizing dynamic behavior of the inserted field comprises the steps of providing a visual editor for defining properties of the inserted field in response to the selection of at least one particular field type of the plurality of

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field types, providing a visual editor for defining error conditions for the inserted field in response to the selection of at least one particular field type of the plurality of field types, and providing a visual editor for defining control operations for the inserted field in response to the selection of at least one particular field type of the plurality of field types.

The limitation of "providing a visual editor for defining properties..." is stated to be found at page 145 of Towers, yet nothing at page 145 of Towers teaches or suggests dynamic customization, nor is there any teaching on page 145 that would link it to the teachings found at pages 229 and 233, the portions selected from Towers stated to teach dynamic customization. Thus, there is no teaching in Towers of customizing a visual appearance of the inserted field using a visual editor for defining properties of the inserted field in response to the selection of at least one particular field type of the plurality of field types.

Boezeman overcomes none of these deficiencies and is believe to be cited only for its disclosure of error conditions as discussed below.

The Examiner admits that Towers fails to disclose providing a visual editor for defining error conditions for the inserted field in response to the selection of at least one particular field type of the plurality of field types. It is only for this proposition that Boezeman appears to be cited. Office Action at page 7. In the portion of Boezeman cited by the Examiner (col. 5:55-60), Boezeman discloses that a graphical sequence editor can be used to synchronize multimedia applications with an event, one of which might be an error condition.

The only motivation provided by the Examiner for adding Boezeman to Towers is to facilitate synchronization. Yet, Applicants can find no teaching in the selected portions of Towers provided, much less the particular page relied upon in making this rejection (page 233), that suggests synchronization is needed or desired. That it is known to use a graphical editor to

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synchronize a starting or stopping of a multimedia application does not mean that there is any reason to modify the teachings of Towers to include such a graphical editor as one of three visual editors for customizing the dynamic behavior of an inserted field. Absent some suggestion or teaching of the need to modify Towers, there can be no motivation for one to apply the teachings of Boezeman to it. See MPEP 2143.01

The Examiner has rejected claim 9 as a system "designed to perform a subset of the method of claim 1" and is rejected "under essentially the same rationale as claim 1." Office Action at page 5. Applicant relies on the arguments of claim 1 in overcoming the rejection of claim 9.

Claims 4 and 6 depend from claim 1 and therefore are also in condition for allowance and the rejection should be withdrawn. Additionally, with respect to claim 6, the Examiner admits that neither Towers nor Boezeman disclose that the step of customizing dynamic behavior includes defining at least one error condition for the inserted field with the visual editor for defining error conditions. Office Action at page 8. Instead, the Examiner asserts that the combination of Towers and Boezeman would have that "capability." Thus, contrary to the requirements of the MPEP, the rejection of claim 6 is a per se hindsight reconstruction based upon two references that are alleged to have a "capability." Even if the two references were properly combined, the only teaching of how that "capability" is actually implemented is found in Applicants' own invention.

Thus, the rejections of claims 3 and 12, as applied to independent claims 1 and 9 as amended, and all claims depending therefrom, should be withdrawn.

V. Ground 3: Rejections over Towers in view of Boezeman in further view of Agarwal

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Claims 5, 13 and 17 stand rejected as assertedly obvious over Towers in view of Boezeman and further in view of Agarwal. Agarwal is directed to a data structure in a document processing system where each page of a document is subdivided into non-overlapping areas. Agarwal appears to be cited by the Examiner only for the proposition that certain fields used within a computer program can be interrelated. *See* Office Action at page 8. Applicants respectfully traverse the rejection.

Each of claims 5, 13 and 17 depends from one of claims 1, 9 or 16, which are believed allowable for the reasons provided above. Furthermore, Agarwal fails to overcome the deficiencies of Towers and/or Boezeman. Thus, for at least the reasons set forth above, claims 5, 13 and 17 are also allowable and the rejections under 35 U.S.C. §103(a) should be withdrawn.

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CONCLUSION

For at least the reasons above, Applicants respectfully request reconsideration of the Application and withdrawal of all outstanding rejections. As the claims are not rendered obvious in view of the applied art, Applicants request allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

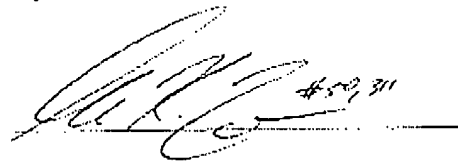
This Response has been filed within three months of the mailing date of the Office Action and it is believed that no additional fees are due with the filing of this Response. The Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: February 21, 2006

Respectfully submitted,

MCNEES WALLACE & NURICK LLC
Attorneys for Applicants

By:

A handwritten signature in black ink, appearing to read "Shawn K. Leppo", with a stylized flourish at the end. To the right of the signature, the number "#50,311" is handwritten.

Shawn K. Leppo, Reg. No. 50,311
P.O. Box 1166
100 Pine Street
Harrisburg, Pennsylvania 17108
Direct Dial: (717) 237-5218
Facsimile: (717) 237-5300